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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/250,340 | 02/16/1999 | YIK HEI SIA | TAY-101 | 1943 |
| 21874 | 7590 | 06/28/2004 | EXAMINER | |
| EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205 | | | KAZIMI, HANI M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3624 | | |

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|-------------------------|----|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/250,340 | SIA, YIK HEI | |
| | Examiner Hani Kazimi | Art Unit 3624 | MW |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,7-21,23-32 and 35-67 is/are pending in the application.
- 4a) Of the above claim(s) 54-67 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,7-21,23-32 and 35-53 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on March 17, 2004. The rejections are as stated below.

Status of Claims

2. Claims 1-5, 7-21, 23-32, and 35-67 are pending in this application, claims 54-67 have been withdrawn from consideration because of the restriction requirement. Therefore, claims 1-5, 7-21, 23-32, and 35-53 are under prosecution in this application. The Applicant is respectfully required to cancel claims 54-67 in response to this office action. The rejections cited are as stated below:

Summary of Office Action

3. Applicants' arguments filed on March 17, 2004 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive. Therefore, claims 1-5, 7-21, 23-32, and 35-53 are rejected as being unpatentable over the art cited below, claims 54-67 have been withdrawn from consideration because of the restriction requirement, and Applicant's request for allowance is respectfully denied.

Response to Applicants' Amendment

Election/Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, 7-21, 23-32, and 35-53 are drawn to a method and a corresponding system for establishing a secure connection or transaction between two entities or stations, classified in 235/382.5.

II. Claims 54-67 are drawn to a verification software module capable of automatically activating and independently launching a series of verifications repeatedly classified in 340/5.2.

5. Newly submitted claims 54-67 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). In the instant case, invention II has separate utility such as activating and independently launching a series of verifications repeatedly. See MPEP § 806.05(d).

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-67 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. In response to this office action, Applicant is respectfully advised to cancel the non-elected claims.

Specification

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1-5, 7-21, 23-32, and 35-53 include the limitations “automatically conducted or conducting”, “wherein said access codes can be *infinitely refreshed*”,

"infinitely rejuvenating and refreshing with new codes via auto-loading", and "without manual customer intervention". However, the specification does not provide an enabling disclosure to support the claimed features of "automatically conducted or conducting", "wherein said access codes can be infinitely refreshed", "infinitely rejuvenating and refreshing with new codes via auto-loading", and "without manual customer intervention".

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-5, 7-21, 23-32, and 35-53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1-5, 7-21, 23-32, and 35-53 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-5, 7-16, 41, and 50-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 1, 41, 50, and 51, the phrases "can be" and "may be" renders the claims indefinite because, it is unclear whether the limitations following the phrase are part of the claimed invention. For further examination purposes, Examiner will interpret the claimed limitations in light of the 35 U.S.C. 112, second paragraph rejection.

Claim Rejections - 35 USC 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

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14. Claims 1-5, 7-21, 23-32, and 35-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zampese US Pat. No. 6,014,650.

Claims 1-5, 7-21, 23-32, and 35-53 are rejected as discussed in paragraphs 5, and 8 of paper number 16. Further:

Zampese fails to teach that if an identical access code is not provided, the accessed part or stations requests three more access codes from the plurality of codes at the accessing part and requires an identical match with a subsequent three access codes at the accessed part in order to conduct the transaction or establish the connection, such that said previously used codes are not deleted but remain in an active state of service.

Official Notice is taken that if an identical access code is not provided, requesting another access code from a plurality of codes for an identical match with a subsequent access code in order to conduct a transaction, and keeping previously used codes in an active state of service is old and well known in the art (e.g. Microsoft e-mail system stores deleted items in an active folder to be accessed by the user at any time).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Zampese to include that if an identical access code is not provided, the accessed part or stations requests three more access codes from the plurality of codes at the accessing part and requires an identical match with a subsequent three access codes at the accessed part in order to conduct the transaction or establish the connection, such that said previously used

codes are not deleted but remain in an active state of service because, it greatly improves the efficiency of the system by providing a system that is more secure and prevent unauthorized transactions and fraud, and a user friendly system by accessing the deleted codes from an active file.

Response to Arguments

15. Applicant's arguments with respect to claims 1-5, 7-21, 23-32, and 35-53 have been considered but are moot in view of the new ground(s) of rejection. The response to Applicant's arguments with respect to the claims is mentioned within the 35 U.S.C. '103 rejections of this office action.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



HANI M. KAZIMI
PRIMARY EXAMINER

Art Unit 3624

June 1, 2004